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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,150	10/28/2005	Nuzhat Ahmed	084532000000US	5268

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TOWNSEND AND TOWNSEND AND CREW, LLP  
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SAN FRANCISCO, CA 94111-3834

EXAMINER
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SINGH, SATYENDRA K

ART UNIT	PAPER NUMBER
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1657

MAIL DATE	DELIVERY MODE
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12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/525,150

Applicant(s)

AHMED ET AL.

Examiner

Satyendra K. Singh

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13, 15 and 17-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 3.1 and 37 CFR 1.475.

In accordance with these rules, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, drawn to **a product**, cell-free immunoreactive **integrin linked kinase (ILK)**.

Group II, claims 6, 8, and 20-22, drawn to **a method of detection of cancer** (as specifically recited in claim 6) comprising determining the presence or absence of immunoreactive ILK (irILK), wherein the presence of irILK is an indication of cancer.

Group III, claim 7, drawn to **A method** for determining the **efficacy of a treatment for cancer** (using the method according to claim 6) comprising determining the concentration or activity of irILK, wherein a decrease in irILK concentration or activity between tests is indicative of the efficacy of any treatment.

Group IV, claims 9 and 10, drawn to **A method** for **assessing the severity of cancer** (using the method of claim 6) comprising determining quantitatively the amount or activity of irILK, and correlating results with those previously determined for various grades or stages of cancer or with one or more other markers of cancer.

Group V, claims 11-13, drawn to **A kit** (i.e. a second product) for carrying out the method of claim 6, said kit comprising means for detecting irILK in biological fluid.

Group VI, claims 15, 17, 18 and 23-25, drawn to **A method of treatment or prevention of cancer** comprising administering to a patient (determined as

suffering therefrom or at risk of developing cancer) an agent capable of blocking the increased expression of ILK, or the effect of increased expression of ILK.

Group VII, claim 19, drawn to **A pharmaceutical composition** (i.e. a third product) comprising an agent (capable of blocking the increased expression of ILK, or the effect of increased expression of ILK) and a pharmaceutically acceptable carrier.

(a) An international or national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those invention involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) a product and a process specially adapted for the manufacture of said product; or

(2) a product and a process of use of said product; or

(3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) a process and an apparatus or means specifically designed for carrying out said process; or

(5) a product, a process specially adapted for the manufacture of the said product and an apparatus or means specifically designed for carrying out said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

The groups (I-VII) of invention do not fall under any of the categories mentioned as above.

PCT Rule 13.2 does not provide for multiple **compositions or multiple methods of use** within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and the additional composition and method claims each constitute a separate group.

In addition to the requirement that a group of inventions must belong to one of the specific categories provided by PCT Rule 13.2, the inventions in the category, such as a composition and a method of use of the composition, must have a special technical feature that unites them. See Patent Rules 1.475, where a special technical feature is a contribution OVER THE PRIOR ART.

Thus, the inventions listed as Groups (I-VII) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features as demonstrated above. Since the product AS CLAIMED (i.e. cell-free immunoreactive ILK, see instant claim 1, in

particular) is known in the art, (see **Persad et al**, section on "*Experimental Procedures*" and figure 1 legend, in particular) no special technical feature unites these inventions in a category.

The expression "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT Rule 13.2). Thus, a feature found in the prior art cannot be considered to be a special technical feature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Species Election***

This application also contains **claims directed to more than one species** of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species claimed in the invention of group VI are as follows:

If the invention of **group VI** (i.e. a method of prevention or treatment of cancer) is elected, Applicant is required to elect **single specie** from each of the claims (or combination of species from different claims) as listed below:

- A. Claims 17 and 18 (in combination) recite species of **agent** (capable of blocking expression of ILK)-

An **Antisense nucleic acid** (for use in gene therapy approach),  
An **anti-ILK antibody**, and  
An **antagonist of ILK activity**.

- B. Claims 24 and 25 (in combination) recite the species of **cancers**-

**Ewing's sarcoma,  
Primitive neuroectodermal tumor,  
Medulloblastoma,  
Neuroblastoma,  
Prostate cancer, and  
Ovarian cancer.**

Applicant is required, in reply to this action, to elect **a single specie as discussed above** (if the invention of group VI is elected for examination) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claim(s) 15 (for the invention of group VI) is deemed generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Pursuant to PCT

Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(I)(B)(2), the species are not art-recognized equivalents.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).



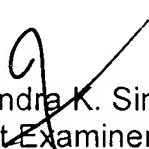
Application/Control Number:  
10/525,150  
Art Unit: 1657

Page 8

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyendra K. Singh whose telephone number is 571-272-8790. The examiner can normally be reached on 9-5MF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Satyendra K. Singh  
Patent Examiner  
Art Unit 1657

  
SANDRA E SAUCIER  
PRIMARY EXAMINER